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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/812,816

03/21/2001

Masahiko Honda

040405/0334

1908

22428

7590

05/02/2006

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT

PAPER NUMBER

2145

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/812,816

Applicant(s)

HONDA, MASAHIKO

Examiner

Jeffrey R. Swearingen

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-12, 14-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) 6, 13 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14-24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/23/2006 has been entered.

### ***Response to Arguments***

2. The limitation of “the body of the received electronic mail includes the second data” is new matter. The specification failed to teach, “the body of the received electronic mail includes the second data”.

3. The Beck reference taught all features of the invention. To simplify matters of prosecution, the Kuzma and Arnold references, while teaching all features of the invention as currently claimed, are withdrawn as rejections. See the expanded claim rejection below, which pointed out columns 1, 5, and 8 of Beck for providing Applicant's means for separating a body of the electronic mail.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Beck et al. (U.S. Patent No. 5,903,723).

6. In regard to claim 1, Beck disclosed *means for separating a body of the electronic mail into first data including text data and second data when the body of the received electronic mail includes the second data; means for inserting an identifier associated with the second data into the first data; and means for sending only the first data with the identifier to the receiving terminal; wherein the identifier permits retrieval of the second data by the receiving terminal*. A user wished to send an email with an attachment. The attachment was “separated” by storing it locally to the sending user. The email message was then transmitted with an “attachment reference” which was a hyperlink that identified the location of the “separated” attachment. See Beck, column 5, lines 6-33. Further see Beck, column 1, lines 36-40, which stated the requirements for transmission of an email attachment “by value” (the body of the received electronic mail included the second data), column 5, lines 15-19, which defined transmission of an email attachment “by reference” (the identifier permits retrieval of the second data by the receiving terminal; an identifier associated with the second data), and column 8, lines 38-40, where a post office of the network system converted a file attachment by value to a file attachment by reference (means for separating... and means for inserting...).

7. In regard to claim 2, Beck is applied as in claim 1. Beck further disclosed *means for storing the second data; wherein the first data with the identifier inserted therein is sent by said sending means to the receiving terminal through the communication line*. Column 5, line 24

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showed the storing of the attachment. Column 5, lines 11-19 showed the transmission of an email message with an “attachment reference” which identified the location of the attachment.

8. In regard to claim 3, Beck is applied as in claim 2. Beck further disclosed *the second data stored in said storing means is sent to the receiving terminal or deleted from the storing means in response to a request from the receiving terminal*. See Beck, column 6, lines 1-7.

9. In regard to claim 4, Beck is applied as in claim 2. Beck further disclosed *means for assigning a temporary tag for the second data and placing the temporary tag into the first data when the second data is separated from the first data, said inserting means replacing the temporary tag with the identifier that permits retrieval of the second data*. This was the step of inserting the “attachment reference”, or pointer into the email message. A “temporary tag” was inherent to the separation of the attachment and insertion of the pointer.

10. In regard to claim 5, Beck is applied as in claim 1. It was inherent to Beck that the email was communicated over the Internet.

11. In regard to claim 6, Beck is applied as in claim 1. As previously shown in the rejection of claim 1, the *second data* which was separated from the *first data* was an email attachment file.

12. In regard to claim 7, Beck is applied as in claim 1. Beck further disclosed *the second data comprises at least one of graphic data and a computer executable program*. See Beck, column 6, line 60.

13. Claim 8 has substantially the same limitations as claim 1.

14. Claim 9 has substantially the same limitations as claim 2.

15. The limitations of claim 10 are substantially the same as the limitations of claim 3.

16. The limitations of claim 11 are substantially the same as the limitations of claim 4.

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17. The limitations of claim 12 are substantially the same as the limitations of claim 5.
18. The limitations of claim 13 are substantially the same as the limitations of claim 6.
19. The limitations of claim 14 are substantially the same as the limitations of claim 7.
20. The limitations of claim 15 are substantially the same as the limitations of claim 1.
21. The limitations of claim 16 are substantially the same as the limitations of claim 2.
22. The limitations of claim 17 are substantially the same as the limitations of claim 3.
23. The limitations of claim 18 are substantially the same as the limitations of claim 4.
24. In regard to claim 19, Beck is applied as in claim 1. Beck further disclosed *the identifier comprises a URL*. See Beck, column 6, lines 23-33.
25. In regard to claim 20, Beck is applied as in claim 1. Beck further disclosed *the identifier is inserted into the first data by appending the identifier to an end of the first data*. Beck, column 6, lines 1-7.
26. The limitations of claim 21 are substantially the same as the limitations of claim 19.
27. The limitations of claim 22 are substantially the same as the limitations of claim 19.
28. The limitations of claim 23 are substantially the same as the limitations of claim 1.
29. In regard to claim 24, Beck is applied as in claim 23. It was inherent that the email message contained text data.
30. The limitations of claim 25 are substantially the same as the limitations of claim 6.
31. The limitations of claim 26 are substantially the same as the limitations of claim 7.
32. The limitations of claim 27 are substantially the same as the limitations of claim 19.
33. The limitations of claim 28 are substantially the same as the limitations of claim 20.
34. The limitations of claim 29 are substantially the same as the limitations of claim 1.

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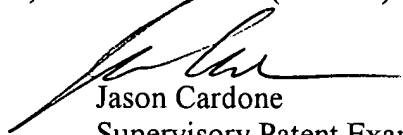
35. The limitations of claim 30 are substantially the same as the limitations of claim 1.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jason Cardone  
Supervisory Patent Examiner  
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